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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,978	07/25/2001	Gabriel Beged-Dov	10014078-1	8178

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MILLER, BENA B

ART UNIT	PAPER NUMBER
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3725

MAIL DATE	DELIVERY MODE
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09/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/915,978

Applicant(s)

BEGED-DOV, GABRIEL

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Adoma.

Adoma teaches in the figures most of the elements of the claimed invention including a disk-shaped body (the figure). However, Adoma may not teach a plurality of fingers disposed in a first circle on said second surface. Adoma teaches on page 5 that clamping device 8 is constructed in a known manner so that the compact disk can be locked in the opening 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of fingers on the second side of the throwable implement of Adoma for the purpose of the retaining the compact disc. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of fingers on the second side of the throwable implement of Adoma, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 1, 2 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Adoma in view of Grobecker et al (US Patent 6,053,311).

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Adoma teaches in the figures most of the elements of the claimed invention including a disc shaped body (the figure). However, Adoma may not teach a plurality of fingers disposed in a first circle on said second surface. Grobecker et al teaches a device for holding CDs having a retaining device (21,25) on its two sides (Fig. 5). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a plurality of fingers on the second side as suggested by Grobecker for the purpose of retaining the compact disc.

Claims 1-5 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Adoma in view of Nusselder (US Patent #4,535,888) or Otsuka et al (US Patent #4,793,479).

Adoma teaches in the figures most of the elements of the claimed invention. However, Adoma may not teach a plurality of flexible fingers having a cantilever portion, a crooked portion, and a ridge portion attached to the second surface of the body. Nusselder teaches in the figures a storage cassette for compact discs having plurality of flexible fingers having a plurality of flexible fingers having a cantilever portion, a crooked portion, and a ridge portion attached to surface body (9, 10, 11). Otsuka et al teaches the it is well known in the prior art to have a plurality of flexible fingers having a cantilever portion, a crooked portion, and a ridge portion attached to body (16) for the attachment of compact discs as seen in fig. 1a, 1b, 2a, 2b. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of flexible fingers, having the claimed features noted

above, as suggested by Nusselder or Otsuka et al for the clamping retention means of Adoma for the purpose of easily mounting and demounting the compact disc.

Response to Arguments

Applicant's arguments filed 06/06/05 have been fully considered but they are not persuasive.

In reference to applicant remarks that Adoma fails to anticipate or in alternative, as obvious over Adoma, the claimed invention, this argument is moot. The examiner has withdrawn the rejection.

In response to applicant's remarks that Adoma does not suggest the claimed invention, applicant's attention is directed above new rejection.

In response to applicant's remarks that the combination of Adoma in view of Nusselder or Otsuka et al fail to teach the claimed invention, the examiner disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

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claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Nusselder or Otsuka et teaches the structure of the claimed plurality of flexible fingers wherein these plurality of flexible fingers are used to lock a compact disc; therefore, as noted above, it would have been obvious to incorporate the plurality of flexible fingers in the device of Adoma for the reasons set forth above.

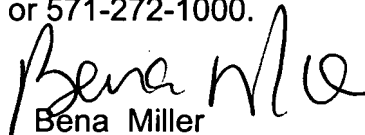
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Bena Miller
Primary Examiner
Art Unit 3725

bbm
September 04, 2007